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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

TRAN, CONGVAN

ART UNIT

PAPER NUMBER

2683

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/467,712

Applicant(s)

AMIN ET AL.

Examiner

CongVan Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) 4,31,32 and 59-62 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30 and 33-58 is/are allowed.
- 6) ☒ Claim(s) 1-3,5,9-14,16,17,19,21,23-26,28 and 29 is/are rejected.
- 7) ☐ Claim(s) 6-8,15,18,20,22 and 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on Jul. 20, 2005 has been entered.

2. Claims 1, 30 have been amended.

3. Claims 4, 31-32, 59-62 have been canceled.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-2, 5, 9-14, 16-17, 19, 21, 23, 26, and 28 are rejected under 35

U.S.C. 102(e) as being anticipated by Alperovich (6,233,448).

Regarding claims 1-2, 5, 9-14, 16-17, 19, 21, 23, 26, and 28, Alperovich discloses a system, method and apparatus for automatic feature activation/deactivation

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based upon positioning, comprising the steps of determining the proximity of a first telephone to a second telephone (see abstract, fig.1, elements 12, 14, col.3, lines 8-64); initiating the transfer of call from the first telephone to the second telephone in response to the proximity (see abstract, fig.1, elements 12, 14, col.4, line 55-col.5, line28); receiving calls on the second telephones (see abstract, fig.1, element 12, and its description). wherein the communication network includes a position node (PN) and in which determining includes the PN collecting position data to track the proximity of the first telephone (see fig.1, element 32 and its description).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alperovich (6,233,448) in view of Hayashin et al. (6,144,318).

Regarding claim 3, Alperovich discloses all the subject matters described in rejected claim 1, except for a wireless location receiver is selected from the group consisting of GPS and short-range position beacon receiver. However, Hayashin discloses a navigation system that uses position of mobile unit to make call management decisions comprising the wireless location receiver is selected from the group consisting of GPS and short-range position beacon receiver (see fig.1, elements 21, 22 and col.4, lines 44-48). Thus, it would have been obvious to one having ordinary

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skill in the art at the time the invention was made to use Hayashin's wireless location receiver in Alperovich's the system to allow the device to figure out precisely where it is on earth.

8. Claims 24-25, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alperovich (6,233,448) in view of Lygas (6,236,868).

Regarding claims 24-25, 29, Alperovich discloses all the subject matters described in rejected claim 1, except the second telephone is an automobile mounted wireless telephone. However, Lygas discloses an apparatus for sensing the presence of a mobile telephone in its holder including the second telephone is an automobile mounted wireless telephone, in which determining that the proximity of the portable telephone to the auto-mounted telephone meets a predetermined threshold (see fig.1, fig.2. col.4, lines 20-51). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Lygas' automobile mounted wireless telephone in Alperovich's invention to detect the proximity of the portable telephone in order to improve in telecommunications system.

Allowable Subject Matter

9. Claims 6-8, 15, 18, 20, 22, 27, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claims 30, 33-58 are allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to CongVan Tran whose telephone number is 571-272-7871. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


CONGVAN TRAN
PRIMARY EXAMINER

CongVan Tran
Primary Examiner
Art Unit 2683

Aug. 06, 2005.